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In re Application of GERBAULT
U.S. Application No.: 09/830,378
Int. Application No.: PCT/FR99/02639
Int. Filing Date: 28 October 1999
Priority Date: 29 October 1998
Attorney Docket No.: 01245/TL
For: DEVICE AND METHOD FOR MAKING
AN INTEGRATED CIRCUIT SECURE

COMMUNICATION

This is in response to applicant's "Second Response to Notification of Missing Requirements" filed 29 May 2002 including a declaration signed by the inventor Eric Gerbault.

The 29 May 2002 response is a proper reply to the decision mailed 03 January 2002.

The application has an International Filing Date of 28 October 1999 and a date under 35 U.S.C. 371 of 29 May 2002.

The application will be forwarded to the United States Designated/Elected Office (DO/EO/US) for processing in accordance with this letter.

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JAN 03 2002

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DECISION

This is in response to petitioner's "Response to Notification of Missing Requirements and Petition to Proceed Under 37 CFR 1.47(b)" filed 07 November 2001.

BACKGROUND

On 28 October 1999, applicant filed international application PCT/FR99/02639, which claimed priority of an earlier France application filed 29 October 1998. A copy of the international application was communicated to the USPTO from the International Bureau on 11 May 2000. A Demand for international preliminary examination, in which the United States was elected, was filed on 08 April 2000, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 30 April 2001 (29 April 2001 was a Sunday).

On 25 April 2001, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 07 June 2001, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 07 November 2001, petitioner filed the present petition under 37 CFR 1.47(b), requesting that the application be accepted for U.S. national stage processing without the signature of the inventor Eric Gerbault.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(i), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. See 37 CFR 1.47(b).

With regard to item (1) above, the requisite fee has been provided.

With regard to item (2) above, MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, petitioner has not established that a bona fide attempt was made to present a complete copy of the application papers to the nonsigning inventor Gerbault for signature. Specifically, although the petition states that a letter containing declaration and assignment forms was sent to the nonsigning inventor Gerbault on 28 August 2001 and signed for

by Gerbault upon receipt (see affidavit of Sophie Diatta and copy of delivery confirmation receipt), petitioner has not shown that the specification, claims, and drawings were ever presented to Gerbault. Furthermore, English language translations of the 28 August 2001 letter, label, and delivery confirmation receipt have not been provided. Moreover, the 28 August 2001 letter apparently does not specify a deadline by which Gerbault is required to respond. Thus, it would not be reasonable to conclude at the present time that Gerbault refuses to sign the application papers.

With regard to item (3) above, the petition states the last known address of the nonsigning inventor.

With regard to item (4) above, an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor(s) has been provided.

With regard to item (5) above, the 37 CFR 1.47(b) applicant must prove that, as of the date the application was deposited in the USPTO, (A) the invention has been assigned to the applicant, or (B) the inventor has agreed in writing to assign the invention to the applicant, or (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify filing of the application. MPEP 409.03(f).

In the present case, petitioner has submitted a document signed by Gerbault which acknowledges the employer's classification of the invention as belonging to Schlumberger Industries S.A. However, this document is neither an executed assignment nor a written agreement to assign the invention. At most, the document serves as evidence that the terms of an agreement to assign the invention have been met, but a copy of such an agreement (e.g. an employment contract) has not been provided. Absent a written agreement to assign the invention along with a statement of facts by a person with firsthand knowledge of the terms of such an agreement being satisfied, petitioner must supply a legal memorandum to the effect that a court of competent jurisdiction would by weight of authority in that jurisdiction award title of the invention to petitioner. The memorandum should be prepared and signed by an attorney familiar with the law of the jurisdiction involved. Such a memorandum must be accompanied by a statement of facts which supports the conclusion of the memorandum and is signed by a person with firsthand knowledge of such facts. See MPEP 409.03(f).

With regard to item (6) above, petitioner has made a statement that filing of the present application is necessary to preserve petitioner's priority rights.

CONCLUSION

Because petitioner has failed to satisfy items (2) and (5) above, the petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this decision is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file a proper response will result in ABANDONMENT of the application. Extensions of time are available pursuant to 37 CFR 1.136. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to the Commissioner for Patents, Box PCT; Washington, D.C. 20231, and address the contents of the letter to the attention of the PCT Legal Office.



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